

REMARKS

Applicants thank the Examiner for the helpful telephone interview regarding claim language to replace the phrase "corresponding to the nucleotide sequence of SEQ ID NO:3". The claims have been amended. New claims 80-102 are identical to claims 33, 34 and 59-79 as amended except that they refer to SEQ ID NO:1 rather than SEQ ID NO:3. SEQ ID NO:1 was included in the elected group (Group XXXXV) and the claims were previously inadvertently deleted (see reply of September 18, 2003). No new matter has been added.

SEQ ID NO:1 is the sequence of the cDNA that includes SEQ ID NO:3, which is the open reading frame for a human alpha-methylacyl-CoA racemase.

Rejections Under 35 U.S.C. § 112, second paragraph

The Examiner rejected claims 33, 34 and 59-79 as indefinite for using the phrase "corresponding to the nucleotide sequence of SEQ ID NO:3". Claim 33 has been amended to refer to "alpha-methylacyl-CoA racemase mRNA comprising the sequence of a nucleic acid molecule consisting of SEQ ID NO:3 or the complete complement thereof". In view of this amendment, Applicants respectfully request that this rejection be withdrawn.

Rejections Under 35 U.S.C. § 112, first paragraph (written description)

The Examiner rejected claims 33, 34 and 59-79 as failing to satisfy the written description requirement. The Examiner argued that since the phrase "corresponding to the nucleotide sequence of SEQ ID NO:3" is not defined in the specification, it is deemed to encompass any variants of methylacyl-CoA racemase mRNA. The Examiner argued that the specification does not provide a written description of all variants of SEQ ID NO:3.

The phrase "corresponding to SEQ ID NO:3" was intended to describe mRNA that is encoded by a nucleic acid molecule having the sequence of SEQ ID NO:3, which the open reading frame of a cDNA (SEQ ID NO:1) identified by the Applicants. Applicants have amended claim 33 to refer to "alpha-methylacyl-CoA racemase mRNA comprising the sequence

of a nucleic acid molecule consisting of SEQ ID NO:3 or the complete complement thereof". Thus, claim 33 now refers to a specific nucleic acid sequence, SEQ ID NO:3, and its complete complement. This clearly meets the written description requirement as set forth in the relevant case law. In view of this, Applicants respectfully request that the rejections based on the written description requirement of 35 U.S.C. §112, first paragraph

Rejections Under 35 U.S.C. § 112, first paragraph (enablement)

The Examiner rejected claims 33, 34 and 59-79 as failing to satisfy the enablement requirement. The Examiner stated that while the specification is enabling for a method of identifying candidate therapeutic agents that includes a step of "measuring the mRNA level of the alpha-methylacyl-CoA racemase SEQ ID NO:3, [it] does not reasonably provide enablement for a method" comprising "measuring the expression level of the alpha-methylacyl-CoA racemase '**corresponding**' to SEQ ID NO:3" (emphasis added).

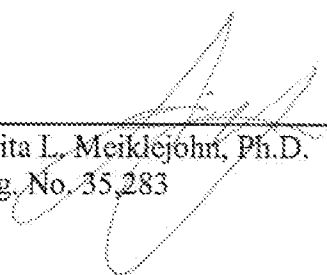
Claim 33 has been amended to refer to "measuring the level of expression of alpha-methylacyl-CoA racemase mRNA comprising the sequence of a nucleic acid molecule consisting of SEQ ID NO:3 or the complete complement thereof" (emphasis added). In view of this amendment and the Examiner's statement that the methods are enabled where they include "measuring the mRNA level of the alpha-methylacyl-CoA racemase SEQ ID NO:3", Applicants respectfully request that the rejections under 35 U.S.C. § 112, first paragraph for lack of enablement be withdrawn.

Applicant : Jennifer Richardson et al.
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A Petition for Extension of Time with the appropriate fee is being filed concurrently with this Reply by EFS. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: 20 Dec 2006 
Anita L. Meiklejohn, Ph.D.
Reg. No. 35,283

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110
Telephone: (617) 542-5070
Facsimile: (617) 542-8906

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